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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,104	06/09/2000	Hiroyoshi Suzuki	16869P010000US	3405
20350	7590	12/30/2004		
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER BATAILLE, PIERRE MICHE	
			ART UNIT 2186	PAPER NUMBER

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/591,104

Applicant(s)

SUZUKI ET AL.

Examiner

Pierre-Michel Bataille

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 1,3,5,8 and 9 is/are allowed.  
6) ☒ Claim(s) 2,4,6 and 7 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is taken in response to Applicant's communication filed October 22, 2004 responding to Official Action dated July 7, 2004. Applicant amendments and/or arguments have been considered with the results that follow.
2. Claims 1-9 are pending in the application under examination.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-9 have been fully considered but are moot in view of new grounds of rejection.

The clause "the storage of a set of user data in the cache memory" lacks proper antecedent basis in claim 6.

In claim 7, it appears that "the user defined information" should be replaced with "user data defining information".

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
- (2) a patent granted on an application for patent by another filed in the United States before

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the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 2, 4, 6-7 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,449,697 (Beardsley et al).

With respect to claim 2, Beardsley discloses an external storage system **(Fig. 1)** having at least one disk drive **(DASD 30)** and having a cache memory **(cache 22)** to store data that is read from the disk drive and to store data to be written to the disk drive **[(data prestaged to cache in preparation for data transfer to host of DASD) Col. 2, Lines 10-26; Col 5, Lines 35-44]**, collectively referred as user data, wherein the user data on the at least one disk drive is stored to the cache memory in response to a first command from the host computer **(prestige command from the first processing unit to the second processing unit which controls access to the storage system, wherein the prestige command causes the second processing unit to prestige into cache the tacks at the addressable locations) Col. 2, Lines 18-23 )** and wherein the user data is removed from the cache memory and stores to the at least one disk drive in response to a second instruction from the host computer **(first processing unit then requests data at the addressable locations indicated in the data structure. In response, the second processing unit returns the requested data from the cache) [Col. 2, Lines 23-26].**

With respect to claims 4, 6-7, Beardsley discloses the storage in or removal from the cache memory of the user data is executed in a processing unit of data set domain [Col. 5, Line 65 to Col. 6, Line 6]; the user data defining

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information includes a data set name which is entered from a terminal connected to the host unit [Col. 5, Line 65 to Col. 6, Line 6].

***Allowable Subject Matter***

6. Claims 1, 35, and 8-9 are allowed.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,594,885 (Lautzenheuser) teaching method for operating a cache memory system using a recycled register for identifying a reuse status of a corresponding cache entry

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre-Michel Bataille whose telephone number is (571) 272-4178. The examiner can normally be reached on Mon-Fri (9:30A to 6:00P).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew M. Kim can be reached on (571) 272-4182. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre-Michel Bataille  
Primary Examiner  
Art Unit 2186

December 24, 2004

**PIERRE BATAILLE**  
**PRIMARY EXAMINER**